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In re Application of : DECISION
Skszek et al. : ON PETITION
Serial No.: 09/851,601 :
Filed : May 9, 2001 :
For: Fabrication of Alloy Variant Structures :
Using Direct Metal Deposition :
:

This is a decision on a petition filed May 22, 2003 (Certificate of Mailing, May 19, 2003) requesting examination of claims 6-10 of the instant application; while not explicitly stated, this is considered to be a petition under 37 CFR 1.144 requesting review of the examiner's restriction requirement.

In the Remand to the Examiner, mailed September 22, 2004, The Board of Patent Appeals and Interferences noted petitions related to restriction requirements are outside the Board's jurisdiction. The Director of the USPTO has delegated the authority to decide petitions regarding a final decision of an examiner required restriction to the Technology Center Directors (MPEP 1002.02(c)).

It is noted, petitions under 37 CFR 1.144 will not be considered if, as in the instant application, reconsideration of the requirement was not first requested. However, in the advisory action mailed June 13, 2003, the examiner treated the petition as a request for reconsideration and responded to the arguments presented. Therefore, the petition will be considered as both a request for reconsideration by the examiner and a petition to review the restriction requirement.

In the office action mailed March 19, 2003, the examiner held that newly submitted claims 6-10 were directed to an invention that was independent or distinct from the invention originally claimed. Specifically, the examiner asserted that the product of claims 6-10 could be made by process that does not require a step of optically monitoring the physical dimensions as is set forth in the process of claims 1-5.

The petitioner argues claims 6-10 are dependent claims that include the optical monitoring requirement and unless the examiner can prove that a different process could be used to make the tooling set forth in the product by process claims 6-10, the claims should be examined.

These arguments are not persuasive. As correctly noted by the petitioner, claims 6-10 are product-by-process claims. As indicated in MPEP 2113, "product-by-process claims are not limited to the manipulations of the recited steps, only by the structure implied by the steps". Furthermore, the PTO bears a lesser burden of proof in dealing with product-by-process claims. The examiner need only show that a prior art product appears to be the same or similar to the claimed product; burden shifts to applicant to provide evidence establishing a difference between the prior art product and the claimed product.

As indicated in the instant specification (page 3, lines 12-21), conventional laser cladding is performed using jigs. While the specification notes the use of jigs is expensive, time consuming and does not produce consistent results for articles having intricate geometries, a product resulting from this conventional process would appear to be the same or similar to the claimed product - particularly for relatively flat geometries. In other words, while the process recited in the claims may produce the article more consistently, in less time, at lower cost and with fewer rejects, the resulting product would still appear to be the same as that produced by the conventional process. The examiner presented similar rebuttals to these arguments in the advisory action mailed June 13, 2003.

The petitioner notes that if one assumes the use of "optical monitoring" represents an improvement enhancing the dimensions of the article, then the article could only be made by the process recited in the product-by-process claims. However, no evidence as been presented showing this to be true, i.e., there is no evidence on the record that the process recited in the claims results in a different product.

In view of the above discussion, having weighed both the examiner's position and the petitioner's arguments, it is concluded that, on the balance, the restriction is proper. The application will be returned to the jurisdiction of The Board of Patent Appeals and Interferences for consideration of the appeal.

The petition is **DENIED**.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Gifford, Krass, Groh
280 N. Old Woodward Ave., Suite 400
Birmingham, MI 48009